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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,992	05/03/2001	Wilfried Lubisch	49500	7169

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STOCKTON, LAURA

[REDACTED] ART UNIT      [REDACTED] PAPER NUMBER

1626

DATE MAILED: 09/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/830,992	LUBISCH ET AL.	
	Examiner Laura L. Stockton, Ph.D.	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 18 June 2003.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.
- 4) Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-26 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Disposition of Claims

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
 a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)                  4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)                  5) Notice of Informal Patent Application (PTO-152)  
 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.                  6) Other: \_\_\_\_\_

## **DETAILED ACTION**

**Claims 1-26 are pending in the application.**

Rejections made in the previous Office Action which do not appear below have been overcome. Therefore, arguments pertaining to these rejections will not be addressed.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in

such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

No support in the specification or the original filed claims can be found for R<sup>3</sup> representing a R<sup>32</sup> substituted imidazole ring or a R<sup>32</sup> substituted pyrrole ring found in claims 1 and 3 (see original claim 3 and the instant specification on page 10). No support in the specification or the original filed claims can be found for the change in the definition of variable K in claim 1. Applicants did not show where support could be found (page number and line number). Therefore, the claims lack written description as such.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are replete with a multitude of errors.

**Claim 1:**

- a) Under the definition of R<sup>2</sup>, “CF3” should be changed to “CF<sub>3</sub>”.
- b) Under the definition of R<sup>2</sup>, “C<sub>1</sub>, -C<sub>6</sub>-alkyl” should be changed to “C<sub>1</sub>-C<sub>6</sub>-alkyl”.
- c) Under the definition of R<sup>24</sup>, “C<sub>1</sub>-C<sub>6</sub>,-alkyl” should be changed to “C<sub>1</sub>-C<sub>6</sub>-alkyl”.
- d) Claim 1 does not conform to M.P.E.P. 608.01(m) since each claim must end with a period and no other periods may be used elsewhere in the claims except for abbreviations {e.g., see under the definitions of R<sup>2</sup>, R<sup>3</sup>, F<sup>2</sup> and R<sup>53</sup>}.
- e) Under the definition of x, “O” should be changed to “0”.

- f) Under the definition of R<sup>3</sup>, “-D-(F<sup>1</sup>)<sub>p</sub>-(E)<sub>q</sub>-(F<sup>2</sup>)<sub>r</sub>-G” should be changed to “-D-(F<sup>1</sup>)<sub>p</sub>-(E)<sub>q</sub>-(F<sup>2</sup>)<sub>r</sub>-G”.
- g) Under the definition of R<sup>3</sup>, “-E-(D)<sub>u</sub>-(F<sup>2</sup>)<sub>s</sub>-(G)<sub>v</sub>” should be changed to “-E-(D)<sub>u</sub>-(F<sup>2</sup>)<sub>s</sub>-(G)<sub>v</sub>”.
- h) R<sup>32</sup> is not defined.
- i) Under the definition of D, “0” should be changed to “O”.
- j) Under the definition of E, “piperidine” is misspelled.
- k) Under the definition of u, “or I” should be changed to “or 1”.
- l) Under the definition of R<sup>53</sup>, “Br, I” should be changed to “Br, I”.
- m) Under the definition of R<sup>53</sup>, “NO<sub>2</sub>” should be changed to “NO<sub>2</sub>”.
- n) Under the definition of R<sup>53</sup>, “C<sub>1</sub>-C<sub>4</sub> alkylarnino” should be changed to “C<sub>1</sub>-C<sub>4</sub> alkylamino”.
- o) Under the definition of R<sup>53</sup>, “C<sub>1</sub>-C<sub>4</sub>-dialkylamino” should be changed to “C<sub>1</sub>-C<sub>4</sub>-dialkylamino”.

- p) Under the definition of A, a space is needed after “unbranched”.
- q) Under the definition of R<sup>8</sup>, “Cl-C<sub>4</sub>-alkylphenyl” should be changed to “C<sub>1</sub>-C<sub>4</sub>-alkylphenyl”.

**Claim 2:**

- a) Under the definition of R<sup>1</sup>, “Cl-C<sub>6</sub>-alkyl” should be changed to “C<sub>1</sub>-C<sub>6</sub>-alkyl”.
- b) Under the definition of R<sup>43</sup>, “Cl-C<sub>4</sub>-alkyl” should be changed to “C<sub>1</sub>-C<sub>4</sub>-alkyl”.
- c) Under the definition of R<sup>53</sup>, “C<sub>1</sub>” should be changed to “Cl”.
- d) Under the definition of R<sup>53</sup>, “l” should be changed to “I”.
- e) Under the definition of R<sup>53</sup>, “NO<sub>2</sub>” should be changed to “NO<sub>2</sub>”.

**Claim 3:**

- a) Under the definition of R<sup>2</sup>, “NR<sup>22</sup>R<sup>23</sup>” lack antecedent basis from claim 1.
- b) R<sup>23</sup>, and its definition, lacks antecedent basis from claim 1.
- c) Under the definition of m and o, “are u” should be changed to “are 0”.
- d) Under the definition of R<sup>53</sup>, a space is needed after “unbranched C<sub>1</sub>-C<sub>6</sub>-alkyl.”.

In claims 1-3, an “or” should be added before the last substituent listed under the definition of R<sup>52</sup> (also the possible substitutable substituents).

Claim 7 lacks antecedent basis from claim 1 because of the definition of R<sup>31</sup>.

In claim 8, “F1” should be changed to “F<sup>1</sup>”.

***Response to Arguments***

Applicants' arguments filed June 18, 2003 have been fully considered. Applicants state that each of the points raised in the previous Office Action has been addressed in amended claims 1, 2, 3, 6, 8 and 23. In response, Applicants have addressed most of the points stated in the previous Office Action but have also introduced more errors.

***Conclusion***

Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

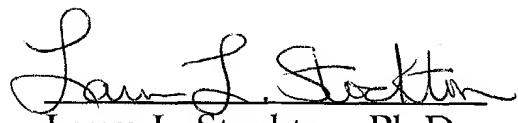
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from

the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (703) 308-1875. The examiner can normally be reached on Monday-Friday from 6:00 am to 2:30 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (703) 308-4537.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.



Laura L. Stockton, Ph.D.  
Patent Examiner  
Art Unit 1626, Group 1620  
Technology Center 1600

September 5, 2003